

## CERTIFICATE OF MAILING (37 C.F.R. 1.8(a))

I hereby certify that this Response (along with any paper referred to as being attached) is being transmitted via facsimile 703-872-9310 to Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date:

9/3/04

  
Rhca C. NersejianIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## In re Application

Inventor(s): Gelfand et al.  
Serial No.: 10/052,417  
Filed: 01/17/2002  
Title: THERMOSTABLE DNA POLYMERASES  
INCORPORATING NUCLEOSIDE  
TRIPHOSPHATES LABELED WITH  
FLUORESC EIN FAMILY DYES

PATENT APPLICATION

Art Unit: 1634  
Examiner: Sitton, Jehanne Souaya  
Confirmation No. 4095

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(c)

Mail Stop Non Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Roche Molecular Systems, Inc. (RMS) having an office at 1145 Atlantic Avenue, Alameda, CA 94501, is the assignee of the entire right, title and interest in, and to the invention described and claimed in the captioned application for Letters Patent of the United States, and in and to said application, and in and to any and all Letters Patent of the United States which may issue from said application.

The present application, U.S. Serial No. 10/052,417, filed January 17, 2002, is a continuation application of U.S. Serial No 09/146,631, filed September 3, 1998, which issued as U.S. Patent No. 6,346,379, which claims the benefit of provisional application 60/058,525 filed September 11, 1997.

The undersigned hereby certifies that the evidentiary documents have been reviewed, and, to the best of undersigned's knowledge and belief, title to the captioned application is in RMS.

RMS hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the captioned application which would extend beyond the expiration date of U.S. Patent No. 6,346,379.

RMS further agrees that any patent so granted on the captioned application, together with any right to recover for its violation, shall be enforceable only for and during such period that the legal title to any patent granted on the captioned application shall be the same as the legal title to U.S. Patent No. 6,346,379. This agreement is to run with any patent granted on the captioned application and is to be binding upon the grantee, its successors or assigns.

RMS does not disclaim the terminal part of the term of any patent granted on the captioned application prior to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No 6,346,379, as presently shortened by any terminal disclaimer, in the event that said patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

RMS makes the above disclaimer without prejudice to its rights to extend, under 35 U.S.C. 154-156, the term of any U.S. patent granted on the captioned application beyond the term provided by this Terminal Disclaimer.

The undersigned has authority to sign since she is an agent of record.

The Commissioner is hereby authorized to charge the required fee of one hundred and ten dollars (\$110.00) as well as any additional fees which may be required, or credit any over payment, to Deposit Account No. 50-0812.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Please address all correspondence regarding this matter to Customer No. 22829.

Respectfully submitted,

Date: September 3, 2004



Rhea C. Nersesian

Registration No. 55,488

Roche Molecular Systems, Inc

1145 Atlantic Avenue

Alameda, CA 94501

Tele: (510) 814-2800

Fax: (510) 814-2973



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MARCH 03, 1998

PTAS

HOFFMANN-LA ROCHE INC.  
GEORGE W. JOHNSTON  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110



\*100614112A\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 12/19/1997

REEL/FRAME: 8901/0619  
NUMBER OF PAGES: 9

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

## ASSIGNOR:

GELFAND, DAVID H. ✓

DOC DATE: 09/11/1997 ✓

## ASSIGNOR:

REICHERT, FRED L. ✓

DOC DATE: 09/11/1997 ✓

## ASSIGNOR:

MYERS, THOMAS W. ✓

DOC DATE: 10/09/1997 ✓

## ASSIGNOR:

KALMAN, LISA V. ✓

DOC DATE: 09/11/1997 ✓

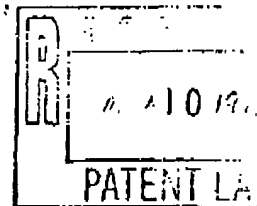
## ASSIGNOR:

SIGUA, CHRISTOPHER L. ✓

DOC DATE: 09/11/1997 ✓

## ASSIGNEE:

ROCHE MOLECULAR SYSTEMS, INC. ✓  
1080 U.S. HIGHWAY 202  
BRANCHBURG, NEW JERSEY 08876



SEP. 3. 2004 11:24AM

RMS Patent Department

NO. 419 P. 12

8901/0619 PAGE 2

SERIAL NUMBER: 60058525 /  
PATENT NUMBER:

FILING DATE: 09/11/1997 -  
ISSUE DATE:

MAYA BENNETT, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

JOINT INVENTION

Case Docket No. 1044P

ASSIGNMENT

WHEREAS, WE, David H. Gelfand, Lisa V. Kalman, Fred L. Reichert, Thomas W. Myers and Christopher L. Sigua (Assignors) have invented certain new and useful improvements which are described and claimed in application for United States Patent and identified as Case Docket No. 1044P, entitled:

**THERMOSTABLE DNA POLYMERASES INCORPORATING NUCLEOSIDE  
TRIPHOSPHATES LABELED WITH FLUORESCCEIN FAMILY DYES**

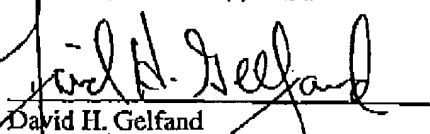
WHEREAS, ROCHE MOLECULAR SYSTEMS, INC., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at Branchburg, New Jersey, is desirous of acquiring the entire interest in and to said invention, said application and the Patent to be obtained therefor;

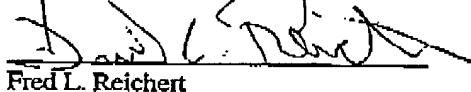
NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) and other good and valuable consideration to us in hand paid, the receipt and sufficiency whereof are hereby acknowledged, we have sold, assigned, and set over, and by these presents do hereby sell, assign, and set over unto the said ROCHE MOLECULAR SYSTEMS, INC. (Assignee), and said Assignee's legal representatives, successors, the entire right, title and interest, for the whole world, in and to said invention and said application, as well as any subsequent application which claims priority based upon the filing date of said application identified as Case Docket No. 1044P and the patents, both domestic and foreign, that may or shall result therefrom including the right to claim in respect of any subsequent United States and foreign patent applications and patents, the priority date of said application under any United States statute and international convention or treaty; and we do hereby authorize and request the issuance of said patents, domestic and foreign, conformably to the terms of this Agreement.

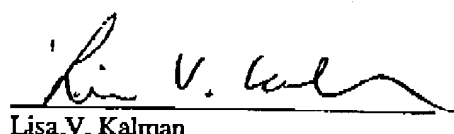
UPON SAID CONSIDERATION, we do hereby covenant and agree with the said Assignee that we will not execute any writing or do any act whatsoever conflicting with these presents, and that we will at any time upon request, without further or additional consideration, but at the expense of the said Assignee, execute such additional assignments and other writings and do such additional acts as said Assignee may deem necessary or desirable to perfect the Assignee's enjoyment of this grant, and render all necessary assistance in making application for and obtaining provisional, original, continuation, continuation-in-part, divisional, reissued, re-examined or extended Patent of the United States or of any and all foreign countries on said invention, and in enforcing any rights or choses in action accruing as a result of such applications or patents, including but not limited to, giving testimony in any proceedings or transactions involving such applications or patents, and executing preliminary statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind and inure to the benefit of the assigns and legal representatives of all parties hereto.

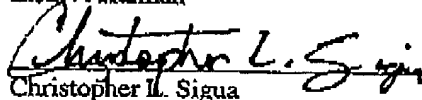
IN WITNESS WHEREOF, we have hereunto set our hands and affixed our seals this //day  
of Sept., 1997.


Alameda, California, U.S.A.

  
David H. Gelfand

  
Fred L. Reichert

  
Lisa V. Kalman

  
Christopher L. Sigua

  
Thomas W. Myers      October 9, 1997

ACKNOWLEDGMENT

United States of America)  
State of California    )  
County of Alameda    )

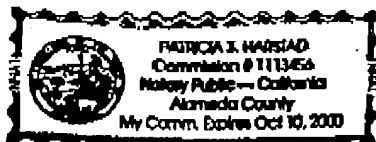
On \_\_\_\_\_, before me personally appeared

to me known to be the persons described in the foregoing Assignment, who acknowledged that they  
executed the foregoing Assignment of their own free will for the purposes therein set forth.

33216

State of California  
 County of Alameda  
 On Sept 11, 1997 before me, Patricia S. Harstad - Notary Public  
Date Name and Title of Officer (e.g., "Jane Doe, Notary Public")  
 personally appeared David H. Gelfand  
Name(s) of Signer(s)

☐ personally known to me - OR - ☒ proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



WITNESS my hand and official seal.

Patricia S. Harstad  
Signature of Notary Public

**OPTIONAL**

*Though the information below is not required by law, it may prove valuable to persons relying on the document and could prevent fraudulent removal and reattachment of this form to another document.*

**Description of Attached Document .**

Title or Type of Document: Assignment

Document Date: 9-11-97 Number of Pages: 2

Signer(s) Other Than Named Above: Thomas W. Myers, Lisa V. Kalman, Thomas W. Myers, Christopher L. Sigua

**Capacity(ies) Claimed by Signer(s)**

Signer's Name: \_\_\_\_\_

- ☐ Individual  
☐ Corporate Officer  
 Title(s): \_\_\_\_\_  
☐ Partner — ☐ Limited ☐ General  
☐ Attorney-in-Fact  
☐ Trustee  
☐ Guardian or Conservator  
☐ Other: \_\_\_\_\_

**RIGHT THUMBPRINT  
 OF SIGNER**  
 Top of thumb here

Signer Is Representing:

Signer's Name: \_\_\_\_\_

- ☐ Individual  
☐ Corporate Officer  
 Title(s): \_\_\_\_\_  
☐ Partner — ☐ Limited ☐ General  
☐ Attorney-in-Fact  
☐ Trustee  
☐ Guardian or Conservator  
☐ Other: \_\_\_\_\_

**RIGHT THUMBPRINT  
 OF SIGNER**  
 Top of thumb here

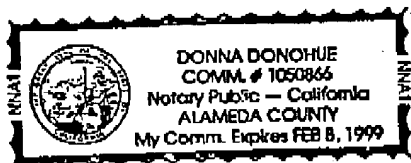
Signer Is Representing:



State of California  
 County of Alameda

On 10-9-97 before me, Donna Donohue Notary  
DATE NAME, TITLE OF OFFICER - E.G., "JANE DOE, NOTARY PUBLIC"  
 personally appeared Thomas W. Myers  
NAME(S) OF SIGNER(S)

☒ personally known to me - OR - ☐ proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



WITNESS my hand and official seal.

Donna Donohue  
SIGNATURE OF NOTARY

**OPTIONAL**

Though the data below is not required by law, it may prove valuable to persons relying on the document and could prevent fraudulent reattachment of this form.

**CAPACITY CLAIMED BY SIGNER**

- ☒ INDIVIDUAL  
☐ CORPORATE OFFICER  
TITLE(S)  
☐ PARTNER(S) ☐ LIMITED  
☐ GENERAL  
☐ ATTORNEY-IN-FACT  
☐ TRUSTEE(S)  
☐ GUARDIAN/CONSERVATOR  
☐ OTHER: \_\_\_\_\_

**SIGNER IS REPRESENTING:**  
NAME OF PERSON(S) OR ENTITY(ES)

Self

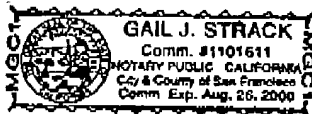
**DESCRIPTION OF ATTACHED DOCUMENT**

Assignment  
TITLE OR TYPE OF DOCUMENT  
2 + acknowledgments  
NUMBER OF PAGES  
Sept. 11, 1997  
DATE OF DOCUMENT  
David Gelman Fred R. Chet  
Lisa Kalman Christopher S. Jones  
SIGNER(S) OTHER THAN NAMED ABOVE

**ALL-PURPOSE ACKNOWLEDGMENT**State of CaliforniaCounty of San FranciscoOn September 11, 1997 before me,Gail J. Strack, Notary Public  
NAME, TITLE OF OFFICER - E.G., JANE DOE, NOTARY PUBLICpersonally appeared Lisa Halman

NAME(S) OF SIGNER(S)

☐ personally known to me - OR - ☒ proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



Witness my hand and official seal.

Gail J. Strack  
SIGNATURE OF NOTARY**CAPACITY CLAIMED BY SIGNER**☒ INDIVIDUAL(S)☐ CORPORATE

OFFICER(S)

TITLE(S)

☐ PARTNER(S)☐ ATTORNEY-IN-FACT☐ TRUSTEE(S)☐ SUBSCRIBING WITNESS☐ GUARDIAN/CONSERVATOR☐ OTHER:**SIGNER IS REPRESENTING:**

NAME OF PERSON(S) OR ENTITY(ES)

ATTENTION NOTARY: Although the information requested below is OPTIONAL, it could prevent fraudulent attachment of this certificate to unauthorized document.

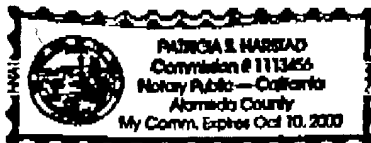
THIS CERTIFICATE  
MUST BE ATTACHED  
TO THE DOCUMENT  
DESCRIBED AT RIGHT:

Title or Type of Document assignmentNumber of Pages 2Date of Document 9-11-97Signer(s) Other Than Named Above David Gelfand, Fred R. Kuehnt, Thomas W. MyersChristopher L. Sigua

© 1997 NATIONAL NOTARY ASSOCIATION • 8228 Redwood Ave. • P.O. Box 7184 • Canoga Park, CA 91304-7184

State of California  
County of Alameda  
On Sept 11, 1997 before me, Patricia S. Harstad - Notary Public  
Date Name and Title of Officer (e.g., "Jane Doe, Notary Public")  
personally appeared Christopher L. Sigua  
Name(s) of Signor(s)

☐ personally known to me - OR - ☒ proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies); and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



WITNESS my hand and official seal.

Patricia S. Harstad  
Signature of Notary Public

OPTIONAL

Though the information below is not required by law, it may prove valuable to persons relying on the document and could prevent fraudulent removal and reattachment of this form to another document.

Description of Attached Document

Title or Type of Document: Assignment

Document Date: 9-11-97 Number of Pages: 2

Signer(s) Other Than Named Above Lisa J. Kalman Thomas Meyer  
David H. Belfrage, Fred R. Reed

Capacity(ies) Claimed by Signer(s)

Signer's Name: \_\_\_\_\_

- ☐ Individual  
☐ Corporate Officer  
Title(s): \_\_\_\_\_  
☐ Partner — ☐ Limited ☐ General  
☐ Attorney-in-Fact  
☐ Trustee  
☐ Guardian or Conservator  
☐ Other: \_\_\_\_\_

RIGHT THUMBPRINT  
OF SIGNER  
Top of thumb here

Signer Is Representing: \_\_\_\_\_

Signer's Name: \_\_\_\_\_

- ☐ Individual  
☐ Corporate Officer  
Title(s): \_\_\_\_\_  
☐ Partner — ☐ Limited ☐ General  
☐ Attorney-in-Fact  
☐ Trustee  
☐ Guardian or Conservator  
☐ Other: \_\_\_\_\_

RIGHT THUMBPRINT  
OF SIGNER  
Top of thumb here

Signer Is Representing: \_\_\_\_\_

**CALIFORNIA ALL-PURPOSE ACKNOWLEDGMENT**

State of

County of

On

Date

before me,

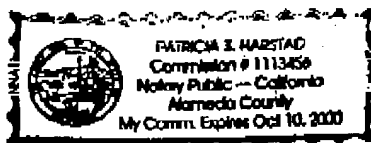
personally appeared

Name and Title of Officer (e.g., "Jane Doe, Notary Public")

Name(s) of Signer(s)

☐ personally known to me - OR - ☒ proved to me on the basis of satisfactory evidence to be the person(s)

whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



WITNESS my hand and official seal.

*Patricia J. Harstad*  
Signature of Notary Public

**OPTIONAL**

Though the information below is not required by law, it may prove valuable to persons relying on the document and could prevent fraudulent removal and reattachment of this form to another document.

**Description of Attached Document**

Title or Type of Document:

Document Date:

Number of Pages: 2

Signer(s) Other Than Named Above:

Capacity(ies) Claimed by Signer(s)

Signer's Name:

- ☐ Individual  
☐ Corporate Officer

Title(s):

☐ Partner — ☐ Limited ☐ General☐ Attorney-in-Fact☐ Trustee☐ Guardian or Conservator☐ Other:

Signer Is Representing:

Signer's Name:

- ☐ Individual  
☐ Corporate Officer

Title(s):

☐ Partner — ☐ Limited ☐ General☐ Attorney-in-Fact☐ Trustee☐ Guardian or Conservator☐ Other:

Signer Is Representing:

**RIGHT THUMBPRINT  
OF SIGNER**  
Top of thumb here

**RIGHT THUMBPRINT  
OF SIGNER**  
Top of thumb here